

PATENT
Customer No. 22,852
Attorney Docket No. 5725.0980-00

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 3639
)
Application No.: 10/024,496) Examiner: Igor N. BORISSOV
)
Filed: December 21, 2001)
)
For: BEAUTY ADVISORY SYSTEM) Confirmation No.: 4463
AND METHOD)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on November 3, 2005.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

TOTAL FEE DUE:

Appeal Brief Fee	\$500.00
Extension Fee (if any)	\$120.00
Total Fee Due	\$620.00


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☒ Enclosed is a check for \$620.00 to cover the above fees.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916. A duplicate copy of this paper is enclosed for use in charging the deposit account.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 3, 2006

By: 
Anthony M. Gutowski
Reg. No. 38,742



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0980-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Gilles RUBINSTENN et al.)	Group Art Unit: 3639
Application No.: 10/024,496)	Examiner: Igor N. BORISSOV
Filed: December 21, 2001)	
For: BEAUTY ADVISORY SYSTEM AND METHOD)	Confirmation No.: 4463

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed November 3, 2005 and further to Board Rule 41.37, Appellants present this brief and enclose herewith a check for the fee of \$500.00 required under 37 C.F.R. § 1.17(c). Also enclosed is a Petition for a one-month extension of time and corresponding fee payment to extend the time period for filing the brief up to February 3, 2006.

This Appeal responds to the August 3, 2005, final rejection of claims 1-50.

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.



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I. REAL PARTY IN INTEREST

The real party in interest is L'OREAL SA, the assignee of the entire right, title, and interest in the application.

II. RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or assignee are aware, that may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-50 have been finally rejected and are subject to this appeal.

IV. STATUS OF AMENDMENTS

No Amendments have been filed since the Final Office Action of August 3, 2005
(*"Final Office Action"*).

V. SUMMARY OF CLAIMED SUBJECT MATTER

A. Independent Claim 1

The subject matter set forth in independent claim 1 relates to a method for providing beauty advice. The method comprises obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject (Fig. 2, 202; Fig. 3; Fig. 9; Fig. 10, 1002, 1004; p. 5, ll. 11-19; p. 6, l. 21 to p. 9, l. 3; p. 17, l. 14 to p. 20, l. 2; p. 37, l. 10 to p. 38, l. 19); determining local information based on the demographic information (Fig. 1; Fig. 2, 204; Fig. 4; Fig. 6; Fig. 10, 1011; p. 5, ll. 19-21; p. 9, ll. 4-15; p. 20, ll. 7-10); generating at least one recommendation for use of at least one cosmetic product based on at least the personal information and the local information (Fig. 1; Fig. 2, 206; Fig. 4; Fig. 6; Fig. 10, 1012; p. 5, l. 21 to p. 6, l. 3; p. 9, l. 16 to p. 11, l. 2; p. 20, ll. 11-17); and presenting the at least one recommendation (Fig. 1; Fig. 2, 208; Fig. 4; Fig. 6; Fig. 10, 1014; p. 5, l. 21 to p. 6, l. 3; p. 11, ll. 3-21; p. 20, ll. 18-21).

B. Independent Claim 25

The subject matter set forth in independent claim 25 relates to a method for providing beauty advice to a subject. The method comprises obtaining personal information about the subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject (Fig. 2, 202; Fig. 3; Fig. 9; Fig. 10, 1002, 1004; p. 5, ll. 11-19; p. 6, l. 21 to p. 9, l. 3; p. 17, l. 14 to p. 20, l. 2; p. 37, l. 10 to p. 38, l. 19); generating a list of a plurality of cosmetic products for the subject (Fig. 4, 410; p. 21, ll. 21-24); receiving from the subject a request for cosmetic advice (p. 5, ll. 19-21; p. 14, ll. 17-19; p. 32, l. 12

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C. Independent Claim 27

The subject matter set forth in independent claim 27 relates to a system for providing beauty advice. The system comprises memory (Fig. 8, 806; p. 16, l. 1 to p. 17, l. 4) for storing personal information about a subject, the personal information including at least demographic information about the subject, the demographic information including a geographic area location of the subject; memory (Fig. 8, 806; p. 16, l. 1 to p. 17, l. 4) for storing a program that accesses local information for the geographic area and generates at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information; and a processor that runs the program (Fig. 8, 802; p. 14, ll. 5-9; p. 15, l. 3 to p. 17, l. 13).

D. Independent Claim 30

The subject matter set forth in independent claim 30 relates to a system for providing beauty advice. The system comprises a memory (Fig. 8, 806; p. 16, l. 1 to p. 17, l. 4) including a program that obtains personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject, determines local information based on the demographic information, generates at least

one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information, and presents the at least one recommendation; and a processor that runs the program (Fig. 8, 802; p. 14, ll. 5-9; p. 15, l. 3 to p. 17, l. 13).

E. Independent Claim 31

The subject matter set forth in independent claim 31 relates to a computer-readable medium (Fig. 8, 806, 820; p. 16, l. 13 to p. 17, l. 4) containing instructions for causing a computer to perform a method for providing beauty advice, the method comprising obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject (Fig. 2, 202; Fig. 3; Fig. 9; Fig. 10, 1002, 1004; p. 5, ll. 11-19; p. 6, l. 21 to p. 9, l. 3; p. 17, l. 14 to p. 20, l. 2; p. 37, l. 10 to p. 38, l. 19); determining local information based on the demographic information (Fig. 1; Fig. 2, 204; Fig. 4; Fig. 6; Fig. 10, 1011; p. 5, ll. 19-21; p. 9, ll. 4-15; p. 20, ll. 7-10); generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (Fig. 1; Fig. 2, 206; Fig. 4; Fig. 6; Fig. 10, 1012; p. 5, l. 21 to p. 6, l. 3; p. 9, l. 16 to p. 11, l. 2; p. 20, ll. 11-17); and presenting the at least one recommendation (Fig. 1; Fig. 2, 208; Fig. 4; Fig. 6; Fig. 10, 1014; p. 5, l. 21 to p. 6, l. 3; p. 11, ll. 3-21; p. 20, ll. 18-21).

F. Independent Claim 32

The subject matter set forth in independent claim 32 relates to a method for providing beauty advice. The method comprises maintaining a plurality of categories, each category being defined by at least one personal characteristic (p. 23, l. 5 to p. 24, l. 9); obtaining information identifying a geographic area where beauty advice is to be

dispensed (Fig. 2, 202; Fig. 3; Fig. 9; Fig. 10, 1002, 1004; p. 5, ll. 11-19; p. 6, l. 21 to p. 9, l. 3; p. 17, l. 14 to p. 20, l. 2; p. 37, l. 10 to p. 38, l. 19); obtaining local information about the geographic area, the local information at least including a weather forecast for the geographic area (Fig. 1; Fig. 2, 204; Fig. 4; Fig. 6; Fig. 10, 1011; p. 5, ll. 19-21; p. 9, ll. 4-15; p. 20, ll. 7-10); generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information and at least one of the plurality of categories (Fig. 1; Fig. 2, 206; Fig. 4; Fig. 6; Fig. 10, 1012; p. 5, l. 21 to p. 6, l. 3; p. 9, l. 16 to p. 11, l. 2; p. 20, ll. 11-17; p. 23, l. 5 to p. 24, l. 9); and presenting the recommendations (Fig. 1; Fig. 2, 208; Fig. 4; Fig. 6; Fig. 10, 1014; p. 5, l. 21 to p. 6, l. 3; p. 11, ll. 3-21; p. 20, ll. 18-21; p. 23, l. 5 to p. 24, l. 9).

G. Independent Claim 41

The subject matter set forth in independent claim 41 relates to a method for providing beauty advice. The method comprises obtaining local information about a geographic area by manipulating received demographic data (Fig. 1; Fig. 2, 204; Fig. 4; Fig. 6; Fig. 10, 1011; p. 5, ll. 19-21; p. 9, ll. 4-15; p. 20, ll. 7-10); generating at least one recommendation for use of at least one cosmetic product based on the information (Fig. 1; Fig. 2, 206; Fig. 4; Fig. 6; Fig. 10, 1012; p. 5, l. 21 to p. 6, l. 3; p. 9, l. 16 to p. 11, l. 2; p. 20, ll. 11-17); and providing at least one entity in the geographic area with the recommendation (Fig. 1; Fig. 2, 208; Fig. 4; Fig. 6; Fig. 10, 1014; p. 5, l. 21 to p. 6, l. 3; p. 11, ll. 3-21; p. 20, ll. 18-21).

H. Independent Claim 43

The subject matter set forth in independent claim 43 relates to a method for providing beauty advice. The method comprises obtaining personal information about a subject, the personal information including at least demographic information about the

subject, the demographic information reflecting a geographic area location of the subject (Fig. 2, 202; Fig. 3; Fig. 9; Fig. 10, 1002, 1004; p. 5, ll. 11-19; p. 6, l. 21 to p. 9, l. 3; p. 17, l. 14 to p. 20, l. 2; p. 37, l. 10 to p. 38, l. 19); determining local information based on the demographic information (Fig. 1; Fig. 2, 204; Fig. 4; Fig. 6; Fig. 10, 1011; p. 5, ll. 19-21; p. 9, ll. 4-15; p. 20, ll. 7-10); generating at least one cosmetic analysis based on at least one of the personal information and the local information (Fig. 1; Fig. 2, 206; Fig. 4; Fig. 6; Fig. 10, 1012; p. 5, l. 21 to p. 6, l. 3; p. 9, l. 16 to p. 11, l. 2; p. 20, ll. 11-17); and presenting the at least one cosmetic analysis (Fig. 1; Fig. 2, 208; Fig. 4; Fig. 6; Fig. 10, 1014; p. 5, l. 21 to p. 6, l. 3; p. 11, ll. 3-21; p. 20, ll. 18-21).

I. Independent Claim 49

The subject matter set forth in independent claim 49 relates to a method for providing beauty advice. The method comprises obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject (Fig. 2, 202; Fig. 3; Fig. 9; Fig. 10, 1002, 1004; p. 5, ll. 11-19; p. 6, l. 21 to p. 9, l. 3; p. 17, l. 14 to p. 20, l. 2; p. 37, l. 10 to p. 38, l. 19); determining local information based on the demographic information and historical information associated with the geographic area (Fig. 1; Fig. 2, 204; Fig. 4; Fig. 6; Fig. 10, 1011; p. 5, ll. 19-21; p. 9, ll. 4-15; p. 20, ll. 7-10); generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (Fig. 1; Fig. 2, 206; Fig. 4; Fig. 6; Fig. 10, 1012; p. 5, l. 21 to p. 6, l. 3; p. 9, l. 16 to p. 11, l. 2; p. 20, ll. 11-17); and presenting the at least one recommendation (Fig. 1; Fig. 2, 208; Fig. 4; Fig. 6; Fig. 10, 1014; p. 5, l. 21 to p. 6, l. 3; p. 11, ll. 3-21; p. 20, ll. 18-21).

VI. GROUNDS OF REJECTION

A. Claims 27-30, 40, 42, and 45 stand rejected under 35 U.S.C. § 112, ¶ 2 as indefinite for failing to particularly point out and distinctly claim the subject matter which Appellants regard as the invention. *Final Office Action* at 2.

B. Claims 1-26 and 32-50 stand rejected under 35 U.S.C. § 101 for allegedly not being within the technological arts. *Id.* at 3-7.

C. Claims 25 and 26 stand rejected under 35 U.S.C. § 102(a) based on WO 01/18674 ("*Maloney*"). *Id.* at 7, 8; Interview Summary of Oct. 25, 2005 ("*Interview Summary*").

D. Claims 1-9, 11-13, 17, 18, 20-24, 27, 30-32, and 34-50 stand rejected under 35 U.S.C. § 103(a) based on *Maloney* and U.S. Patent No. 5,796,932 ("*Fox*"). *Final Office Action* at 8-17; *Interview Summary*.

E. Claim 10 stands rejected under 35 U.S.C. § 103(a) based on *Maloney*, *Fox*, and U.S. Patent Application Publication No. 2002/0082869 ("*Anderson*"). *Final Office Action* at 17, 18.

F. Claim 19 stands rejected under 35 U.S.C. § 103(a) based on *Maloney*, *Fox* and Official Notice. *Id.* at 19.

G. Claims 14-16, 28, 29, and 33 stand rejected under 35 U.S.C. § 103(a) based on *Maloney*, *Fox*, and U.S. Patent Application Publication No. 2002/0059248 ("*Farchione*"). *Id.* at 18, 19.

VII. ARGUMENT

A. The Rejection Under 35 U.S.C. § 112, ¶ 2 Should Be Reversed

1. Claims 27-30

a. There is no confusion about whether claims 27-30 are directed to a computer-readable medium or to a system because the claims expressly and clearly recite that they are directed to a “system” comprising *inter alia* “memory” and a “processor.”

For claim 27, the Examiner alleged that the recitation of a “*memory for storing a program that accesses local information . . . and generates at least one recommendation . . .*” makes [the] claim confusing, because it is not clear whether the claim [is] directed to a computer-readable medium for storing instructions, or to the system.” *Final Office Action*, at 2 (italics in original).

Appellants note that the essential inquiry pertaining to the requirement for definiteness under § 112 is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. M.P.E.P. § 2173.02 (8th Ed. May 2004). The M.P.E.P. states:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. *Id.*

Furthermore, the M.P.E.P. makes clear that:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as . . . the examiner might desire. *Id.*

As such, claim 27 is fully compliant with the requirements of 35 U.S.C. § 112, ¶ 2. Specifically, claim 27 is not ambiguous as to whether it is directed to a computer-readable medium or to a system because it expressly recites that it is directed to a "system," which comprises *inter alia* "memory for storing personal information," "memory for storing a program," and a "processor that runs the program." Accordingly, the subject matter defined by claim 27 is unambiguous pursuant to M.P.E.P. § 2173.02, and a skilled artisan would be apprised of the claim's scope from the claim language and supporting disclosure. Further, the language of claim 27 is not confusing and, as required by the notice function of § 112, provides clear warning to others as to what constitutes infringement of the claimed invention. For at least these reasons above, claim 27, and its dependent claims 28 and 29, are fully compliant with 35 U.S.C. § 112, ¶ 2.

With regard to claim 30, the Examiner alleged that the recitation of a "*memory including a program that obtains personal information about a subject . . .*" makes [the] claim confusing, because it is not clear whether the claim [is] directed to a computer-readable medium for storing instructions for performing a method, or to the system." *Final Office Action* at 2 (italics in original). Contrary to the Examiner's allegation, claim 30 is fully compliant with the requirements of 35 U.S.C. § 112, ¶ 2. Specifically, claim 30 expressly recites that it is directed to a "system," which comprises, *inter alia*, "memory including a program that obtains personal information about a subject" and a "processor that runs the program." Accordingly, the subject matter defined by claim 30 is unambiguous, and a skilled artisan would be apprised of the claim's scope from the claim language and supporting disclosure. The language of claim 30 is not confusing

and provides clear warning to others as to what constitutes infringement of the claimed invention. For at least these reasons, claim 30 complies with 35 U.S.C. § 112, ¶ 2.

In summary, there is no confusion on whether claims 27-30 are directed to a computer-readable medium or to a system because the claims expressly and clearly recite that they are directed to a “system” comprising *inter alia* “memory” and a “processor.”

2. Claims 40, 42, and 45

a. Appellants intend claims 40, 42, and 45 to cover methods conducted at least in part in a network environment, regardless of which part is conducted in the network environment. Accordingly, the language of claims 40, 42, and 45 defines a claim scope consistent with Appellants’ intended claim scope.

Claims 40, 42, and 45 recite, *inter alia*, methods for providing beauty advice “conducted at least in part in a network environment.” The Examiner alleged that the term “at least in part” renders these claims indefinite. *Final Office Action* at 2. According to the Examiner, “[i]t is not clear which part of said method is conducted in a network environment.” *Id.* However, contrary to the Examiner’s allegation, the subject matter defined by claims 40, 42, and 45 is set forth with a reasonable degree of clarity and particularity. See M.P.E.P. § 2173.02.

Further, the M.P.E.P. states that:

Breadth of a claim is not to be equated with indefiniteness. . . . If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. (Internal citations omitted). *Id.* § 2173.04

In the present application, claims 40, 42, and 45 are not indefinite merely because their breadth encompasses methods conducted at least in part in a network environment.

Appellants intend claims 40, 42, and 45 to cover such methods, regardless of which part is conducted in the network environment. Accordingly, the language of claims 40, 42, and 45 defines a claim scope consistent with Appellants' intended claim scope.

Also, the Examiner should note that "[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not . . . as the examiner might desire." *Id.* § 2173.02. The scope of the subject matter embraced by claims 40, 42, and 45 is clear as discussed above, and Appellants should not be required to further limit the claims merely because the language is not written as the Examiner desires. For at least these reasons, claims 40, 42, and 45 comply with 35 U.S.C. § 112, ¶ 2.

B. The Rejection Under 35 U.S.C. § 101 Should Be Reversed

1. Claims 1-26 and 32-50

The Examiner alleged that the claims are not within the technological arts because they are (1) completely silent with regard to technology, (2) directed to abstract ideas, and (3) not in compliance with M.P.E.P. § 1206 (IV)(B)(2)(b) "Statutory Process Claims." *Final Office Action* at 3, 7, 8.

a. In *Ex parte Lundgren*, the Board has determined that there is no separate "technological arts" test to determine eligible subject matter under § 101. Accordingly, it is improper to require the claims to recite some technological means to carry out a process or computer-related limitations under such "technological arts" test.

Regarding the first point, the Examiner alleged that the claims are silent with regard to technology and he also alleged that they are completely devoid of any means to carry out a process. *Id.* at 6. In an attempt to support this, the Examiner cited *In re Musgrave*, 167 U.S.P.Q. 280 (CCPA 1970). *Id.* at 3. That case, however, states that the presumption that the law "requires all steps of a statutory 'process' to be physical

acts applied to physical things” is an “erroneous idea.” *In re Musgrave*, 167 U.S.P.Q. at 289. The court noted that “it was a misconstruction to assume that ‘all processes, to be patentable, must operate physically upon substances.’” *Id.* Additionally, the Federal Circuit has indicated arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999). Furthermore, in *Ex parte Bowman*, 61 U.S.P.Q.2d 1669 (2001), also cited by the Examiner, the Board’s decision to affirm the § 101 rejection was based in part on the fact that neither the claims nor the specification discussed “the use of any technology with respect to the claimed invention.” *Ex parte Bowman*, 61 U.S.P.Q.D.2d at 1671. The Board found that the invention was “not tied to any technological art . . . and [was] not a useful art.” *Id.*

The specification in this application, however, discusses several technological applications related to the claimed invention. Also, claims 12, 17, 26, 40, 42, and 45 specifically recite subject matter related to a network, which clearly involves technology. Hence, the claims are indeed within the useful or technological arts, regardless of whether they specifically recite means to carry out a process or computer-related limitations.

In summary, the Examiner provides no authority whatsoever supporting a requirement that a statutory method claim must include limitations reciting technological means to carry out a process. Indeed, in *Ex parte Lundgren*, the Board has determined that there is no such separate “technological arts” test to determine eligible subject matter under § 101. *Ex parte Lundgren* (Bd. Pat. App. & Int., No. 2003-2088, Oct. 2005). Accordingly, it is improper to apply a “technological arts” test requiring the

claims to recite some technological means to carry out a process or computer-related limitations.

b. Generating at least one recommendation for use of at least one cosmetic product based on at least obtained personal information and local information based on demographic information, in claim 1, is a useful, non-abstract result that could facilitate, for example, providing beauty advice and improving beauty marketing and sales

Regarding the second point, the Examiner alleged that the claims are directed to abstract ideas because they are no more than a suggested idea of recommending a cosmetic product based on demographic information. *Final Office Action* at 6. To support this, the Examiner cited *In re Toma*, 197 U.S.P.Q. 852 (CCPA 1978). *Id.* at 4, 5. That case, however, makes clear that the language in the case law regarding mental steps and technological arts “was not intended to form a basis for a new § 101 rejection” *In re Toma*, 197 U.S.P.Q. at 857. Further, if a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 1375 (Fed. Cir. 1998); *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). And, if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101. *See id.*

The Examiner’s conclusory statement that the claims are directed to “purely an abstract idea” is unsupported and does not establish that the claims are in fact directed to an abstract idea. *Final Office Action* at 6. Claims 1-26 and 32-50 do in fact include recitations that produce “concrete, tangible and useful” results and, therefore, accomplish a practical application. *State Street*, 149 F.3d at 1375. For example, generating at least one recommendation for use of at least one cosmetic product based

on at least obtained personal information and local information determined based on demographic information, in claim 1, is a useful, non-abstract result that could facilitate, for example, providing beauty advice and improving beauty marketing and sales.

c. The specification discusses several technological applications related to the invention defined in claims 1-26 and 32-50, thereby showing “a practical application in the technological arts” with respect to those claims.

Regarding the third point, the Examiner alleged that the claims do not comply with M.P.E.P. § 1206 (IV)(B)(2)(b) because they “do not include limitations that would suggest a computer is being used” and “there does not appear to be any physical transformation of data.” *Final Office Action* at 7.

M.P.E.P. § 2106(IV)(B)(2)(b) states, however, that a claimed process is statutory if it is “limited to a practical application within the technological arts.” Specifically, M.P.E.P. § 2106(IV)(B)(2)(b)(ii) clearly states that:

A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. (internal citations omitted).

Hence, regardless of whether the claims recite a process that results in a physical transformation outside a computer, the claims are limited to a practical application within the technological arts if the claims produce concrete, tangible and useful results.

In the present application, the Examiner's allegations are inconsistent. While alleging that the claims “do not include limitations that would suggest a computer is being used,” the Examiner also alleged that the claimed “determining” may be “understood as . . . accessing [a] database.” *Final Office Action* at 8. Since accessing a database involves the use of technology, the Examiner's allegation regarding

“accessing [a] database” serves only to show that the claims are indeed within the technological arts, producing concrete, tangible and useful results.

Additionally, M.P.E.P. § 2106(II)(A) states:

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101 . . . [w]hen such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection. (internal citations omitted).

In this case, the Examiner failed to establish the *prima facie* showing required by M.P.E.P. § 2106. The Examiner’s conclusory statements are unsupported by evidence and do not establish that the claims are in fact “devoid of any limitation to a practical application in the technological arts.”

Finally, within the context of 35 U.S.C. § 101, the Examiner should consider the accompanying disclosure when construing a claim’s practical application. See M.P.E.P. §§ 2106(II)(A). Further, Appellants are entitled to point out portions of the specification to show that practical application of claims. In this case, the specification discusses several technological applications related to the invention defined in claims 1-26 and 32-50, thereby showing “a practical application in the technological arts” with respect to those claims.

Therefore, for at least the above-noted reasons, the rejection of claims 1-26 and 32-50 under 35 U.S.C. § 101 should be reversed.

C. The Rejection Under 35 U.S.C. § 102(a) Should Be Reversed

1. Claims 25 and 26

a. Testing for environmental information, as disclosed by *Maloney*, is not the same as and is not consistent with “accessing local information for the geographic area.”

In order to properly anticipate a claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim[s].” See M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

For claim 25 and its dependent claim 26, *Maloney* fails to teach at least “accessing local information for the geographic area,” as recited in claim 25 and required by claim 26. The Examiner asserts at page 8 of the *Final Office Action* that *Maloney* teaches the claimed “accessing” because it mentions delivering a test kit including environmental tests to identify external conditions, such as water hardness. *Maloney*, at 11, lines 11-12; at 10, lines 7-8. However, testing for environmental information, as disclosed by *Maloney*, is not the same as and is not consistent with “accessing local information for the geographic area,” as recited in claim 25.

b. Providing a list of products and then customizing a product selected from the list does not constitute generating a list of products and then generating a recommendation for use of a product on that list.

Maloney also fails to teach “generating at least one recommendation for use of at least one cosmetic product on the list, the at least one recommendation being a function of the personal information of the subject and the local information,” as recited in claim 25 and required by dependent claim 26. In *Maloney*’s system, a consumer “is provided a list of one or more products . . . that correspond to the consumer profiling category.”

Id., at 7, lines 13-14. *Maloney* mentions that profiling data can include information obtained from environmental tests. *Id.*, at 11, lines 6-23. *Maloney* also describes identifying, from the consumer, additional profiling data “to customize a product selected from the list to meet the consumer’s physiological conditions and external conditions (such as water hardness, etc.).” *Id.*, at 10, lines 6-8. As such, even if *Maloney*’s “environmental” information were consistent with the claimed “local information,” providing a list of products based on such information does not constitute generating a list of products and then generating a recommendation for a product on that list, where the recommendation is a function of the personal information of the subject and the local information. The mere act of providing a list of products does not constitute generating a recommendation for use of a product on a list of products.

Also, even if *Maloney*’s additional profiling data related to “external conditions” were consistent with the claimed “local information,” customizing a product selected from a list to meet external conditions does not constitute generating a list of products and then generating a recommendation for a product on that list. Simply customizing a product is not consistent with generating a recommendation.

Accordingly, for at least the above reasons, the rejection of claims 25 and 26 under 35 U.S.C. § 102(a) as anticipated by *Maloney* should be reversed.

D. The Rejection Under 35 U.S.C. § 103(a) Based On *Maloney* and *Fox* Should Be Reversed

1. Claims 1-9, 11-13, 17, 18, 20-24, 30, 31, and 48

a. Identifying consumer profile data to customize a selected product to meet the consumer’s physiological and environmental conditions, as disclosed in *Maloney*, and depicting the effect of weather variables on sales for a given product at a particular location for a particular time period, as disclosed in *Fox*, is not the same as and does not suggest

generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in claim 1.

To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” *Id.*

For independent claim 1, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information, which is determined based on demographic information, as recited in the claim.

In contrast, *Maloney* merely discloses identifying consumer profile data to customize a selected product to meet the consumer’s physiological and environmental conditions. *Maloney*, at 10, lines 6-8. *Fox* merely discloses depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. *Fox*, col. 16, lines 36-39. This may involve collecting data impacted by weather, such as demographical data. *Id.*, col. 9, lines 20-24. However, neither *Maloney* nor *Fox* teaches or suggests, separately or in combination, generating at least one recommendation for use of at least one cosmetic product based on at least

personal information and local information, which is based on demographic information, as recited in claim 1.

For instance, even if *Maloney's* "environmental" information were consistent with the claimed "local information," providing a list of products based on such information does not constitute generating a recommendation for use of at least one cosmetic product, where the recommendation is a function of the personal information of the subject and the local information. The mere act of providing a list of products does not constitute generating a recommendation for use of at least one cosmetic product.

Also, even if *Maloney's* additional profiling data related to "external conditions" were consistent with the claimed "local information," customizing a product selected from a list to meet external conditions does not constitute generating a recommendation for use of at least one cosmetic product. Simply customizing a product is not consistent with generating a recommendation.

Further, *Fox* does not cure the above deficiencies of *Maloney*. As mentioned above, *Fox* merely discloses depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. *Fox*, col. 16, lines 36-39.

Further, there is no motivation to combine *Maloney* and *Fox* to yield the invention of claim 1. The Examiner asserts that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow [one] to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care, thereby maximizing profits." *Final Office Action* at 9. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the

consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for the product at a particular location for a particular time period. This is not the same as and does not suggest generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information, which is determined based on demographic information, as recited in claim 1. Accordingly, the Examiner has not provided any motivation to modify *Maloney* with *Fox* to yield a method that comprises the "generating" feature of claim 1.

2. Claim 27

a. The Examiner misinterpreted claim 27 and has not shown any teaching or suggestion of several limitations.

For independent claim 27, the Examiner states that *Maloney* fails to "teach that said local information is determined *based on* said demographic information" and asserts that *Fox* cures these deficiencies. *Final Office Action* at 9 (italics in original). Specifically, the Examiner asserts that *Fox* discloses "determining local weather information based on . . . demographic information." *Id.* Appellants note, however, that claim 27 does not recite that local information is determined based on demographic information. Instead, claim 27 recites, *inter alia*, memory for storing a program that accesses local information for the geographic area. As such, the Examiner has not presented a *prima facie* case demonstrating that *Maloney* and *Fox*, separately or in combination, teach or suggest "memory for storing personal information about a subject;" "memory for storing a program that accesses local information . . . and generates at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject

and the local information;" and "a processor that runs the program," as recited in claim 27.

In *Maloney's* system, a consumer "is provided a list of one or more products . . . that correspond to the consumer profiling category." *Maloney*, at 7, lines 13-14. *Maloney* mentions that profiling data can include information obtained from environmental tests. *Id.*, at 11, lines 6-23. *Maloney* also describes identifying, from the consumer, additional profiling data "to customize a product selected from the list to meet the consumer's physiological conditions and external conditions (such as water hardness, etc.)." *Id.*, at 10, lines 6-8. However, even if *Maloney's* "environmental" information were consistent with the claimed "local information," providing a list of products based on such information does not constitute generating a recommendation for use of at least one cosmetic product, where the recommendation is a function of the personal information of the subject and the local information. The mere act of providing a list of products does not constitute generating a recommendation for use of at least one cosmetic product.

Also, even if *Maloney's* additional profiling data related to "external conditions" were consistent with the claimed "local information," customizing a product selected from a list to meet external conditions does not constitute generating a recommendation for use of at least one cosmetic product. Simply customizing a product is not consistent with generating a recommendation.

Fox does not cure the above deficiencies of *Maloney*. *Fox* merely discloses depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. *Fox*, col. 16, lines 36-39. This may involve

collecting data impacted by weather, such as demographical data. *Id.*, col. 9, lines 20-24.

Further, there is no motivation to combine *Maloney* and *Fox* to yield the invention recited in claim 27. The Examiner asserts that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow [one] to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care, thereby maximizing profits." *Final Office Action* at 9. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for the product at a particular location for a particular time period. This is not the same as and does not suggest generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information, as recited in claim 27. Accordingly, there is no motivation to modify *Maloney* with *Fox* to yield a method that comprises generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information, as recited in claim 27.

3. Claims 32-40

a. ***Maloney* and *Fox* do not disclose generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes a weather forecast, as recited in claim 32.**

For independent claim 32 and its dependent claims 33-40, and as affirmed by the Examiner on page 13 of the Office Action, *Maloney* does not disclose, *inter alia*, obtaining local information including a weather forecast. Consequently, *Maloney* can

not disclose generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes a weather forecast, as recited in claim 32. Further, *Fox* does not teach or suggest this claimed "generating" feature. For instance, even if *Fox* were to disclose obtaining a weather forecast, *Fox* does not disclose generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes the weather forecast. Because the applied art does not teach or suggest each and every feature of claim 32, *prima facie* obviousness has not been established with respect to that claim.

The Examiner also asserts that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow [one] to utilize forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care, thereby maximizing profits." *Final Office Action* at 13, 14. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for the product at a particular location for a particular time period. This is not the same as generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes the weather forecast, as recited in claim 32. Accordingly, *Maloney* and *Fox* fail to teach or suggest the invention in claim 32, and there is no motivation to combine *Maloney* and *Fox* to yield the invention in claim 32.

4. Claims 41 and 42

a. Providing a list of products based on data received from environmental tests provided to a consumer does not constitute generating at least one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data, as recited in claim 41

For independent claim 41 and its dependent claim 42, neither *Maloney* nor *Fox*, nor any combination thereof, teaches or suggests “generating at least one recommendation for use of at least one cosmetic product based on the information,” as recited in the claim. Contrary to the Examiner’s allegations on pages 14 and 15 of the Office Action, *Maloney* does not teach or suggest the claimed “generating” feature. *Maloney* describes providing a list of products corresponding to a consumer profiling category, and it mentions that profiling data can include information obtained from environmental tests. *Maloney*, at 7, 9, 11. Even if *Maloney*’s environment test data were consistent with “local information” and *Maloney*’s list of products were consistent with “at least one recommendation,” *Maloney*’s disclosure regarding providing a list of products does not teach or suggest the claimed “generating” feature. That is, providing a list of products based on data received from environmental tests provided to a consumer does not constitute generating at least one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data, as recited in claim 41.

Maloney also describes identifying, from the consumer, additional profiling data “to customize a product selected from the list to meet the consumer’s physiological conditions and external conditions (such as water hardness, etc.).” *Id.*, at 10, lines 6-8. This functionality does not teach or suggest the claimed “generating” feature.

Customizing a selected product to meet external conditions does not constitute generating at least one recommendation for use of at least one cosmetic product, let alone generating a recommendation based on local information obtained by manipulating received demographic data, as recited in claim 41.

Fox does not appear to teach or suggest the claimed "generating" feature and thus fails to cure *Maloney's* deficiencies. Accordingly, the applied references, taken alone or in combination, fail to teach or suggest each and every feature of claim 41.

Further, there is no motivation to combine *Maloney* and *Fox* to yield the invention in claim 41. The Examiner asserts that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow [one] to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care, thereby maximizing profits." *Final Office Action* at 15. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for the product at a particular location for a particular time period. This is not the same as and does not suggest generating at least one recommendation for use of at least one cosmetic product, let alone generating a recommendation based on local information obtained by manipulating received demographic data. Accordingly, there is no motivation to modify *Maloney* with *Fox* to yield a method that comprises generating at least one recommendation for use of at least one cosmetic product based on local information obtained by manipulating received demographic data, as claimed in claim 41.

5. Claims 43-47

a. Providing a list of consumer services or goods does not constitute generating at least one cosmetic analysis, as recited in claim 43.

For independent claim 43 and its dependent claims 44-47, neither *Maloney* nor *Fox*, nor any combination thereof, teaches or suggests, *inter alia*, generating at least one cosmetic analysis based on at least one of the personal information and the local information, as recited in the claim. *Maloney*'s list of products could include "consumer services (such as film development)" or "consumer goods (such as beauty care products, clothing, electronics, etc.)." *Maloney*, at 7, lines 14-17. Providing a list of consumer services or goods, however, does not constitute generating at least one cosmetic analysis, as recited in claim 43. Further, *Fox* does not appear to teach or suggest "generating at least one cosmetic analysis," as claimed, and thus fails to cure *Maloney*'s deficiencies.

The Examiner asserts that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow [one] to utilize local actual and historical weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care, thereby maximize profits." *Final Office Action* at 16. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. This is not the same as generating at least one cosmetic analysis based on at least one of the personal information and the local information, as recited in claim

43. Accordingly, there is no motivation to modify *Maloney* with *Fox* to yield the invention recited in claim 43.

6. Claims 49 and 50

a. Neither *Maloney* nor *Fox*, nor any combination thereof, teaches or suggests, *inter alia*, generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information, which is based on demographic information and historical information associated with a geographic area.

For independent claim 49 and its dependent claim 50, neither *Maloney* nor *Fox*, nor any combination thereof, teaches or suggests, *inter alia*, generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information, which is based on demographic information and historical information associated with the geographic area, as recited in claim 49. The Examiner asserts that it would have been obvious to modify *Maloney* with the disclosure of *Fox* because "it would advantageously allow to utilize local actual and historical weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care, thereby maximizing profits." *Final Office Action* at 17. However, even if this were true, this motivation would only yield the combination of identifying consumer profile data to customize a selected product to meet the consumer's physiological and environmental conditions and depicting the effect of weather variables on sales for a given product at a particular location for a particular time period. This is not the same as generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and local information, which is based on demographic information and historical information

associated with the geographic area, as recited in claim 49. Accordingly, there is no motivation to modify *Maloney* with *Fox* to yield the invention recited in claim 49.

E. The Rejection Under 35 U.S.C. § 103(a) Based On *Maloney*, *Fox*, and *Anderson* Should Be Reversed

1. Claim 10

a. The Examiner's allegation that the alleged modification "would advantageously allow [a determination and exclusion of] certain beauty product ingredients . . ." is not properly supported and does not establish that it would have been obvious to modify *Maloney* and *Fox* with *Anderson* in a manner resulting in Appellants' claimed combination

Claim 10 depends upon claim 1 and includes all limitations recited in claim 1. As discussed above for claim 1, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, at least generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in the claim. *Anderson* fails to cure the deficiencies of *Maloney* and *Fox*. *Anderson* merely discloses a method for providing and updating customized health care information based on an individual's genome. *Anderson*, Abstract. The method might include obtaining the personal data of the individual. *Anderson*, p. 2, ¶ [0016]. This does not teach or suggest, separately or in combination with *Maloney* and *Fox*, generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information.

Further, the Examiner asserts that a skilled artisan would have modified *Maloney* and *Fox* with the disclosure of *Anderson* "because it would advantageously allow [a determination and exclusion of] certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a

predisposition." *Final Office Action* at 18. Appellants first note that the requisite motivation for combining *Maloney* and *Fox* is lacking for at least the reasons presented above in connection with claim 1. Secondly, the Examiner's allegation that the alleged modification "would advantageously allow [a determination and exclusion of] certain beauty product ingredients . . ." is not properly supported and does not establish that it would have been obvious to modify *Maloney* in a manner resulting in Appellants' claimed combination. For example, the Examiner pointed to no mention in *Maloney*, *Fox*, or *Anderson* regarding excluding beauty product ingredients based on negative health conditions or predispositions. The Examiner also failed to show that the alleged motivation would have been in the knowledge generally available to one skilled in the art. Hence, the Examiner is improperly using Appellants' claims in hindsight to reconstruct the prior art.

F. The Rejection Under 35 U.S.C. § 103(a) Based On *Maloney*, *Fox*, and *Farchione* Should Be Reversed

1. Claims 14-16, 28, 29, and 33

a. *Farchione* merely discloses a method for selecting fashion information for an individual and fails to cure the deficiencies of *Maloney* and *Fox*.

Claims 14-16, 28, 29, and 33 depend upon one of claims 1, 27, and 32 and include all limitations recited in their base claims, respectively. As discussed above for claim 1, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, at least generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local information that is based on demographic information, as recited in the claim. For claim 27, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, generating at least one recommendation for use of at least one cosmetic product based on at least personal information and local

information. For claim 32, *Maloney* and *Fox* fail to teach or suggest, separately or in combination, generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information that includes the weather forecast. *Farchione* fails to cure these deficiencies of *Maloney* and *Fox*. *Farchione* merely discloses a method for selecting fashion information for an individual. *Farchione*, Abstract. The method is directed towards training sales agents in product knowledge and application as well as providing an individual a personal analysis and review of the combinations of cosmetic colors and clothing colors that are most appropriate for the individual based on skin color, hair color, eye color, body shape and body proportion. *Id.*, at 1, ¶ [0003].

Further, the Examiner asserts that a skilled artisan would have modified *Maloney* and *Fox* with the disclosure of *Farchione* because “it would advantageously allow to provide customers with a product most suitable for customer’s physical characteristics.” *Final Office Action* at 19. Appellants first note that the requisite motivation for combining *Maloney* and *Fox* is lacking for at least the reasons presented above in connection with claims 1, 27, and 32. Secondly, *Farchione* fails to cure the lack of the motivation for combining *Maloney* and *Fox*.

F. The Rejection Under 35 U.S.C. § 103(a) Based On *Maloney*, *Fox*, and Official Notice Should Be Reversed

1. Claim 19

a. The Official Notice rejection is improper because the Office Action fails to establish that the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known.

An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable

demonstration as being well-known. The features recited in claim 19 were not unquestionably well-known and the Office Action has failed to demonstrate the contrary. Stating that “it is well known that . . . a lot of consumers have a habit to use cosmetic product[s] every day” does not, in and of itself, establish that such subject matter was in fact well known. *Final Office Action* at 19. Moreover, the Examiner’s allegation that “it is well known that . . . a lot of consumers have a habit to use cosmetic product[s] every day” does not establish that the “suggesting” feature of claim 19 was unquestionably well-known. That consumers might use cosmetic products daily does not support the assertion that it was well known to suggest “that the subject maintain a stock of the plurality of cosmetic products,” as claimed. Even if it were well known that “a lot of consumers have a habit to use cosmetic product[s] every day,” this subject matter does not constitute “suggesting that the subject maintain a stock of the plurality of cosmetic products.”

M.P.E.P. § 2144.03 makes clear, with regard to Official Notice, that “[t]he standard of review applied to findings of fact is the “substantial evidence” standard under the Administrative Procedure Act (APA)” (citations omitted). M.P.E.P. § 2144.03 points out that “an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (citations omitted).

Further, M.P.E.P. § 2144.03(B) states that “if Official Notice is taken of a fact, unsupported by documentary evidence, the technical line of reasoning underlying a decision to take such notice must be clear and unmistakable.” Specifically, M.P.E.P. § 2144.03(B) makes clear that:

[If] . . . official notice has been taken of a fact that is asserted to be "common knowledge" without specific reliance on documentary evidence . . . , the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. . . The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made. (internal citations omitted).

The Office Action fails to provide substantial evidence on the record to support the taking of Official Notice. The Examiner merely makes a conclusory statement that certain subject matter was well-known, without supporting documentary evidence and without a clear and unmistakable technical line of reasoning supporting a decision to take the Official Notice.

Additionally, *prima facie* obviousness has not been established with respect to claim 19 at least because the requisite motivation to modify *Maloney* in view of *Fox* and Official Notice is lacking. The requisite motivation to modify *Maloney* in a manner resulting in the invention defined by claim 19 is lacking for at least the reasons presented above in connection with claim 1, upon which claim 19 depends. The Examiner's allegation that a skilled artisan would have modified *Maloney* "because without maintaining said stock the consumer may run out of cosmetic product . . ." is not properly supported and does not establish that it would have been obvious to modify *Maloney* in a manner resulting in Applicants' claimed combination.

Finally, as noted above, M.P.E.P. § 2141.02 makes clear that "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious,

but whether the claimed invention as a whole would have been obvious (internal citations omitted). Even if it were obvious or well known that “a lot of consumers have a habit to use cosmetic product[s] every day,” the Examiner failed to establish that claim 19 as a whole, including the “suggesting” feature would have been obvious. For at least the foregoing reasons, the Examiner failed to meet the burden of supporting a *prima facie* conclusion of obviousness.

VIII. CONCLUSION

For the reasons given above, all of the claim rejections applied to pending claims 1-50 should be reversed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



By: Reg. No. 38,742
Kenie Ho
Reg. No. 51,808

Dated: February 3, 2006

IX. CLAIMS APPENDIX

1. (Previously presented) A method for providing beauty advice, the method comprising:

obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject;

determining local information based on the demographic information;

generating at least one recommendation for use of at least one cosmetic product based on at least the personal information and the local information; and

presenting the at least one recommendation.

2. (Original) The method of claim 1, wherein the local information includes a weather forecast.

3. (Original) The method of claim 1, wherein the local information includes data on cosmetic usage of others located in the geographic area of the subject.

4. (Original) The method of claim 1, wherein the local information includes air quality data for the geographic area of the subject.

5. (Original) The method of claim 1, wherein the local information includes climate data for the geographic area of the subject.

6. (Original) The method of claim 1, wherein the local information includes ecological data for the geographic area of the subject.

7. (Original) The method of claim 1, wherein the personal information further includes at least one of an image, physical characteristics information, lifestyle information, environmental information, nutritional information, medical history information, dietary supplement usage information, and family history information.

8. (Original) The method of claim 7, wherein the lifestyle information includes at least one of fashion preferences, clothing color preferences, and cosmetic preferences.

9. (Original) The method of claim 7, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics.

10. (Original) The method of claim 7, wherein the family history information includes historical physical characteristics information about relatives of the subject.

11. (Original) The method of claim 1, wherein the recommendation is based on a combination of physical characteristics information about the subject, climate data for the geographic area of the subject, and at least one of fashion and color preferences of the subject.

12. (Original) The method of claim 1, further comprising receiving over a network, at a site remote from the subject, the personal information about the subject, and transmitting the recommendation to the subject over the network.

13. (Original) The method of claim 1, further comprising receiving variable preference information from the subject, and wherein the generated recommendation is a function of physical characteristics information, the local information, and the variable preference information.

14. (Original) The method of claim 13, wherein the variable preference information includes an identification of clothing that the subject intends to wear, and

wherein the recommendation contains a suggestion to use at least one product complementary to the identified clothing.

15. (Original) The method of claim 14, wherein the identification of clothing is a color of clothing that the subject intends to wear.

16. (Original) The method of claim 14, wherein the product is a cosmetic product for adding color to a face of the subject.

17. (Original) The method of claim 1, implemented over a network having an subject-accessible node, and wherein the method further comprises prompting the subject to seek cosmetic advice by accessing the node immediately prior to a time when the subject intends to apply a cosmetic product.

18. (Original) The method of claim 17, wherein the time immediately prior is one of an evening before or a day of intended cosmetic application.

19. (Original) The method of claim 1, further including notifying the subject of a plurality of cosmetic products from which the recommendations will be generated, and suggesting that the subject maintain a stock of the plurality of cosmetic products.

20. (Original) The method of claim 1, further comprising receiving from the subject an identification of products at the subject's immediate disposal.

21. (Original) The method of claim 7, wherein the physical characteristics information includes at least one of color, tone, texture, elasticity, oiliness, and pH of at least one of the subject's hair and skin.

22. (Original) The method of claim 1, further comprising receiving a request from the subject for beauty advice.

23. (Original) The method of claim 22, wherein the at least one recommendation is generated in response to the request.

24. (Original) The method of claim 1, wherein the recommendation is based on both the personal information and the local information.

25. (Original) A method for providing beauty advice to a subject, the method comprising:

obtaining personal information about the subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject;

generating a list of a plurality of cosmetic products for the subject;

receiving from the subject a request for cosmetic advice;

accessing local information for the geographic area; and

generating at least one recommendation for use of at least one cosmetic product on the list, the at least one recommendation being a function of the personal information of the subject and the local information.

26. (Original) The method of claim 25, conducted at least in part in a network environment, wherein receiving the request occurs via a network and in at least one location remote from a location of the subject.

27. (Previously Presented) A system for providing beauty advice, the system comprising:

memory for storing personal information about a subject, the personal information including at least demographic information about the subject, the demographic information including a geographic area location of the subject;

memory for storing a program that accesses local information for the geographic area and generates at least one recommendation for use of at least one cosmetic product, the at least one recommendation being a function of the personal information of the subject and the local information; and

a processor that runs the program.

28. (Original) The system of claim 27, wherein the processor is also configured to generate at least one suggestion for clothing based on at least the local information.

29. (Original) The system of claim 27, wherein the at least one cosmetic product is chosen from makeup and hair products.

30. (Original) A system for providing beauty advice, the system comprising:
a memory including a program that
obtains personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject,
determines local information based on the demographic information,
generates at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information, and
presents the at least one recommendation; and
a processor that runs the program.

31. (Original) A computer-readable medium containing instructions for causing a computer to perform a method for providing beauty advice, the method comprising:

obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject;

determining local information based on the demographic information;

generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information; and presenting the at least one recommendation.

32. (Original) A method for providing beauty advice, the method comprising: maintaining a plurality of categories, each category being defined by at least one personal characteristic;

obtaining information identifying a geographic area where beauty advice is to be dispensed;

obtaining local information about the geographic area, the local information at least including a weather forecast for the geographic area;

generating a plurality of differing cosmetic product usage recommendations, each recommendation being a function of the local information and at least one of the plurality of categories; and

presenting the recommendations.

33. (Original) The method of claim 32, wherein presenting includes presenting the recommendations to a beauty consultant.

34. (Original) The method of claim 32, wherein presenting includes organizing recommendations by category.

35. (Original) The method of claim 32, wherein the local information includes data on cosmetic usage of a plurality of individuals located in the geographic area.

36. (Original) The method of claim 32, wherein the at least one personal characteristic includes at least one of physical attributes, lifestyle preferences, fashion preferences, color preferences, cosmetic product preferences, nutritional preferences, medical history, dietary supplement usage, and family history.

37. (Original) The method of claim 36, wherein the physical attributes include at least one of age, skin condition, skin tone, propensity to tan, hair color, and facial feature characteristics.

38. (Original) The method of claim 32, wherein the local information includes at least one of air quality data, temperature data, precipitation data, humidity data, wind data, ultra-violet radiation data, ecological data, and other climate information.

39. (Original) The method of claim 32, further comprising receiving variable preference information about a subject to receive beauty advice, and wherein the at least one generated recommendation is a function of physical characteristics information, the local condition information, and the variable preference information.

40. (Original) The method of claim 32 conducted at least in part in a network environment, wherein obtaining information identifying the geographic area and obtaining the local information occur via a network and in at least one location remote from the geographic area, and wherein presenting the recommendations occurs via the network.

41. (Previously Presented) A method for providing beauty advice, the method comprising:

obtaining local information about a geographic area by manipulating received demographic data;

generating at least one recommendation for use of at least one cosmetic product based on the information; and

providing at least one entity in the geographic area with the recommendation.

42. (Original) The method of claim 41 conducted at least in part in a network environment, wherein obtaining information occurs via a network and in at least one location remote from the entity, and wherein during providing, the recommendations are provided to the entity over the network.

43. (Original) A method for providing beauty advice, the method comprising:
obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject;

determining local information based on the demographic information;
generating at least one cosmetic analysis based on at least one of the personal information and the local information; and
presenting the at least one cosmetic analysis.

44. (Original) The method of claim 43, wherein the cosmetic analysis includes at least one of a recommendation for use of a cosmetic product, a recommendation for a diagnosis to be performed on the subject, a recommendation to follow a beauty treatment regimen, and a prognosis for an external body condition of the subject.

45. (Original) The method of claim 43 conducted, at least in part in a network environment, wherein obtaining personal information occurs via a network and in at

least one location remote from a location of the subject, and wherein during presenting, the at least one cosmetic analysis is presented to the subject via the network.

46. (Original) The method of claim 43, wherein the local information reflects at least one of a local weather condition, a local air quality condition, and a local ultraviolet level.

47. (Original) The method of claim 43, wherein the at least one cosmetic analysis is based on both the personal information and the local information.

48. (Previously Presented) The method of claim 1, wherein determining local information based on the demographic information comprises determining the local information by manipulating the demographic information.

49. (Previously Presented) A method for providing beauty advice, the method comprising:

obtaining personal information about a subject, the personal information including at least demographic information about the subject, the demographic information reflecting a geographic area location of the subject;

determining local information based on the demographic information and historical information associated with the geographic area;

generating at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information; and presenting the at least one recommendation.

50. (Previously Presented) The method of claim 49, wherein determining local information comprises projecting local information based on the demographic information and the historical information associated with the geographic area.

X. EVIDENCE APPENDIX

None.

XI. RELATED PROCEEDINGS APPENDIX

None.